

belief that claim 6 is allowable, applicant requests entry and consideration of amended claim 8 as dependent from amended claim 6 and of new dependent claims 12-16 which incorporate limitations of claims 8-10. Claims 9-10 have been cancelled without prejudice. Claims 1-5 and 11, drawn to non-elected inventions, also have been cancelled without prejudice. Therefore, claims 6-16 are under consideration.

Pursuant to 37 C.F.R. §2.116, applicants state that the amendments to claims 6 and 7 are necessary to more particularly point out and distinctly claim applicants' invention, and to place the case in condition for allowance or in better form for appeal. Amended claim 8 and new claims 12-16, based on non-elected original claims 8-10 and dependent from generic claims 6 or 7 are necessary to fully claim the species of applicant's invention and are proffered in the belief that the generic claims are allowable, and to place the case in condition for allowance or in better form for appeal. The amended and new claims were not proffered previously because the issues they respond to were not yet clear and because, as to claims 8 and 12-16, applicants were awaiting allowance of a generic claim.

A Notice of Appeal is filed herewith.

Applicant hereby petitions under 37 C.F.R. §1.136 for a three month extension of time for response to the final rejection.

Summary

Applicants thank the Examiner for the helpful suggestions in connection with the objections and rejections

under 35 U.S.C. § 112. Responsive amendments have been made, as discussed in more detail below.

In particular, and without limitation, applicants wish to point out two limitations of claim 6 which render the claims allowable.

First, we point out that the words "A hand-held tool" in line 1 of claim 6 constitute a limitation distinguishing the cited prior art and that limitation is "structural." The office action has maintained the rejection based on Stolpe and Schweitzer in part by noting that this phrase is located in the preamble and by asserting that no structure has been added to the body of the claim to distinguish this aspect of the invention from the prior art. We respectfully traverse. Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history. See *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1573, 40 U.S.P.Q.2d 1481, 1488 (Fed. Cir. 1996). In the present case, it is clear from the specification and from our previous amendment dated February 26, 1997 that the limitation to "hand-held" defines the invention that is claimed. This would require construing the literal meaning of the claims as limited to hand-held tools for the purposes of patentability. Accordingly, it is proper to use this limitation to distinguish the claimed

invention from the cited prior art, neither of which appears to disclose a "hand-held tool" by any stretch of the imagination.

Further, the phrase "hand-held tool" is a structural limitation, because it connotes a size and weight limitation to those skilled in the art.

Second, claim 6 has been amended to include the limitation: "said means for rotating comprising at least one handle attached to one of said shearing elements." This limitation is generic to the embodiments of Figs 2a-2c and 3-5.

We recognize that the office action, in paragraphs 9 and 11 has taken the position that the elements identified by the characters (88,82) of Schweitzer and (e',f') of Stolpe are "handles." Applicants respectfully disagree. Schweitzer describes element 82 as a "downwardly depending arm" and element 88 as a "radial extension." (Col. 8, lines 5 and 14) Stolpe describes elements e' and f' as "arms." (Page 2, line 10, referring to Fig. 6) Neither the figures nor the descriptions of those elements disclose what one skilled in the art would understand to be "handles." For example, the relevant definition of the noun "handle" in Webster's Ninth New Collegiate Dictionary, p. 550 (1983) is

1: a part that is designed esp. to be grasped by the hand....

We further point out that, pursuant to *Markman v. Westview Instr. Inc.*, 52 F.3d 967, 34 USPQ 2d 1321 (Fed. Cir. 1995) (*en banc*), *aff'd* 116 S.Ct. 1384, 38 USPQ 2d 1461 (1996) and *Vitronics Corp. v. Conceptiontronics, Inc.*, 90 F.3d 1576, 39 USPQ 2d

1573 (Fed. Cir. 1996), if the claims are allowed on the basis of Applicants' arguments, they will be construed in the light of the successful arguments.

The numbered paragraphs in the following Detailed Remarks refer to the like-numbered paragraphs commencing at page 2 of the Action.

Detailed Remarks

1. Entry of the March 3, 1997 amendment was acknowledged.

2. Applicants thank the Examiner for approval of the new declaration filed March 3, 1997.

3. Applicants thank the Examiner for approval of the proposed drawing corrections filed March 3, 1997. The corrections will be made following allowance of claims, in the usual fashion.

4 & 5. In paragraph 4, the disclosure was objected to under 35 USC 112, ¶ 1, as failing to provide an adequate written description of the invention. In paragraph 5, claims 6 and 7 are rejected for the reasons stated in the objection.

In particular, the office action states that it is not considered clear how the pieces are being separated "and thus not clear whether sufficient support is provided in the specification for the term 'cutting' as set forth in the claims." (Office Action, p. 2 bottom - p.3 top) The Office Action then particularly discusses Figs. 1a-1c.

Applicants call attention to the fact that the elected claims presently under consideration are directed primarily to the embodiment of Figs. 2a-2c, and that the "invention" which requires a "written description" is the claimed structure, not the mode of operation upon the object being cut. They further point out that, in the last amendment of claim 6, line 1, the term "shearing" was substituted for "cutting."

Applicants submit that it would be clear to one skilled in the pertinent art to whom the "written description" is addressed, from the written disclosure relating to Figs. 2a-2c and from those figures, that the primary mode of operation of the claimed structure is cutting by shearing and that--if the axis of relative rotation of the discs is maintained consistent with the axis of the body being cut--the final separation in materials such as the disclosed osteosynthetic plates will occur by fracture at the axis induced by torsion.

Applicants point out the apparent inconsistency of the Office Action in contending in paragraph 4 that the written description of the invention (of claims 6 and 7) is inadequate, while asserting in paragraph 11 that the same invention is obvious.

Further clarifying amendments have been made in the claims to more particularly point out and distinctly claim applicants' invention.

6. Claims 6-7 were rejected under 35 U.S.C. § 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Applicants thank the Examiner for his helpful suggestions for clarification of the claims. Responsive clarifying amendments have been made in the claims to more particularly point out and distinctly claim applicants' invention.

7-8. Claim 6 was again rejected under 35 U.S.C. § 102(b) as being anticipated by Stolpe (US 690,083), as follows:

"Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b, l', l') for rotating the elements counter to one another."

Applicants submit that their amended claims are distinguished from Stolpe, *inter alia*, for the reasons discussed in the Summary above.

9. Claims 6 and 7 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Schweitzer (US 4,887,447), as follows:

"Schweitzer discloses a cutting apparatus with every structural limitation of the claimed invention including an upper shearing element in the form of a disc (78), a lower shearing element in the form of a disc (76), and means (including 10, 52, 54 and 28) for rotating the elements counter to one another, wherein each of the shearing elements has slot (96, 94) with a cutting edge which extends from the outer periphery toward the center and narrows toward the center, and a respective handle (88, 82) connected to each of the discs."

Applicants submit that their amended claims are distinguished from Schweitzer, *inter alia*, for the reasons discussed in the Summary above. The claims require that the device is a hand-held tool, not a large, cumbersome device to which the body to be cut

must be brought, and require one or more handles attached to the shearing elements which are not disclosed in either cited reference.

10-11. Claim 7 was again rejected under 35 U.S.C. § 103 as being unpatentable over Stolpe in view of Schweitzer.

The rejection read as follows:

"Stolpe discloses a cutting apparatus (e.g. in Figure 2) with almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above."

The rejection is respectfully traversed. First, Applicants submit that their claims are distinguished from the cited references, *inter alia*, for the reasons discussed in the Summary and Detailed Discussion above. Second, it is not seen that there is any suggestion in either reference to combine the two references as set forth in the rejection. In particular, neither reference alone or in combination suggests Applicant's advantageous, claimed hand-held tool, and neither suggests applicant's handles attached to the shearing elements, a limitation now included in all claims.

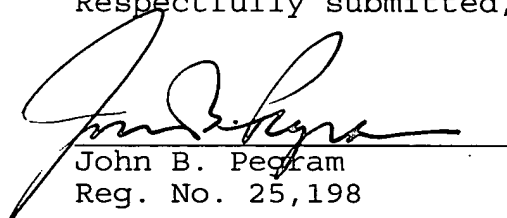
12. Paragraph 12 of the Office Action is the Examiner's response to the last amendment by the Applicants. We believe that the matters discussed there have been adequately addressed by Applicants' amendments, most of which were responsive to the section 112 issues, and the discussion above.

Conclusion

Claims 6, 7 and 8, as amended, are believed to be allowable. For that reason, Applicants have also submitted new claims 12-16, dependent from allowable claim 6 and based on original claims 8-10 which were of the elected genus.

Reconsideration and allowance of those claims is requested. In the event any of those claims are not considered allowable, entry for the purpose of appeal is respectfully requested. A telephone interview is invited if the Examiner believes it would contribute to resolution of any remaining issues.

Respectfully submitted,


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